

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 40-53 are pending in the present application. Claims 1-9, 12-14, and 27-30 have been canceled. Support for new claims 40-53 may be found generally throughout the specification and specifically in previously pending claims 1-9, 12-14, and 27-30.

In the outstanding Official Action, claims 1-9, 12-14, and 27-30 were rejected under judicially created doctrine as allegedly being drawn to an improper Markush group. Applicants respectfully traverse this rejection.

In imposing the rejection, the Official Action contends that applicants do not point to a community of chemical or physical characteristics, which justify their inclusion in a common group, and such inclusion is not repugnant to principles of scientific classification. However, applicants believe that the Patent Office improperly places this burden on applicants.

The Examiner is respectfully reminded that is improper for the Patent Office to refuse to examine that which applicants regard as their invention, unless the subject matter in the claims lack unity of invention. *In re Harnish*, 631 F.2d 716, 206

USPQ 300 (CCPA 1980); *in ex parte Hozumi*, 3 USPQ2d 1059 (BPAI 1984). The Examiner's attention is further directed to Section 803.02 of the MPEP that provides that unity invention exists for compounds included within a Markush group that (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

However, the outstanding Official Action fails to provide any evidence that the claimed compounds lack unity of invention. Indeed, the Official Action does not even attempt to show that the claims lack a common utility or do not share a substantial structural feature together. Rather, the Official Action makes the unsupported allegation that the claims are drawn to an improper Markush group.

Nevertheless, applicants note that claims 1-9, 12-14, and 27-30 have been canceled. New claims 40-53 have been added and are directed to the compounds of Formula I bis and to a process for preparing these compounds. In particular, the Examiner's attention is respectfully directed to dependent claims 46-51, which are directed towards the elected compound.

As a result, applicants believe that claims 40-53 are in good order and request that the Examiner withdraw the improper Markush rejection.

Claims 1-9, 12-14, and 27-30 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants believe the present amendment obviates this rejection.

As noted above, claims 1-9, 12-14, and 27-30 have been canceled. New claims 40-53 have been added. New claims 40-53 are directed to the compounds of Formula I bis and a process for preparing these compounds. As a result, Applicants believe that claims 40-53 are definite to one of ordinary skill in the art.

Claims 1-9, 12-14, and 27-30 were also rejected under 35 USC §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

The Examiner is respectfully reminded that the express teaching of a patent specification cannot be controverted by mere speculation and unsupported assertions on the part of an Examiner. As stated by the Court of Customs and Patent Appeals in the case of *In re Dinh-Nguyen and Stenhagen*, 181 USPQ 46 (CCPA 1974):

Any assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protections sought must be supported by evidence or reasoning substantiating the doubt so expressed.

181 USPQ at 47.

Indeed, applicants believe that such a statement must be carefully applied and supported by evidence when the statement is in direct conflict with the teachings of the specification itself. When reviewing the position outlined by the Official Action, it is apparent that no evidence has been made of record that is inconsistent with the teaching of the specification.

However, as noted above, claims 1-9, 12-14, and 27-30 have been canceled. New claims 40-53 have been added. New claims 40-53 are directed to the compounds having the Formula I bis and a process of preparing these compounds. The claimed compounds are described in detail in the present specification beginning at page 24. As to the elected compound, the Examiner's attention is respectfully directed to page 96 beginning at line 16. A detailed description as to how these compounds are made begin on page 78 of the present specification. Thus, it is believed that the present disclosure is enabling for claims 40-53.

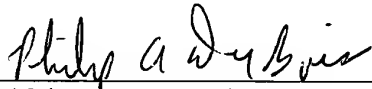
In view of the present amendment and the foregoing remarks, therefore, it is believed that the present application is now in condition for allowance, with claims 40-53, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

Application No. 09/904,459
Amdt. dated December 23, 2003
Reply to Office Action of September 24, 2003
Docket No. 0508-1068

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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